

REMARKS

Claims 1 to 11 and 20 to 23 were pending in the present application when last examined; claims 12 to 19 were withdrawn. Applicant has amended claims 1, 11, 20, and 23, and canceled claims 5, 7, and 8. Claims 1 to 4, 6, 9 to 11, and 20 to 23 remain pending.

Claim Objections

The Examiner objected to claim 1 for informalities. Applicant has amended claim 1 to correct these informalities.

§ 112 Rejection

The Examiner rejected claim 5 under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has canceled claim 5, thereby rendering its rejection moot.

 §§ 102 and 103 Rejections**Claims 1 and 5**

The Examiner rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Prior Art ("APA") in view of U.S. Patent Application Publication No. 2004/0211966 ("Guenther et al.") and U.S. Patent Application Publication No. 2003/0143423 ("McCormick et al."). The Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of McCormick et al. and U.S. Patent No. 6,787,897 ("Geefay et al.").

To expedite prosecution and without prejudice, Applicant has amended claim 1 with the limitations of claim 5, and canceled claim 5. Accordingly, Applicant addresses the rejections of both claims 1 and 5.

Geefay et al. is disqualified by 35 U.S.C. § 103(c) as prior art in the 35 U.S.C. § 103(a) rejection. 35 U.S.C. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsection (c), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c) (emphasis added). The present application and Geefay et al. were, at the time the invention of present application was made, owned by or subject to an obligation of assignment

to Agilent Technologies, Inc. See MPEP §706.02(l)(2). Thus, Geefay et al. is disqualified as prior art against the present application.

Furthermore, Applicant notes that the Examiner cited element 401 on a gasket 201 of Geefay et al. as the recited caulking agent. However, Geefay et al. states that element 401 is a non-conductive bonding material. "FIG. 4C shows an alternative method for applying non-conductive bonding material 401." Geefay et al., col. 4, lines 3 and 4. Thus, Geefay et al. does not disclose a caulking agent in addition to a bonding agent.

For the above reasons, amended claim 1 is patentable over the cited references.

Claims 2, 3, 4, 6, 21, and 22

Claims 2, 3, 4, 6, 21, and 22 depend from amended claim 1 and are patentable for at least the same reasons as amended claim 1.

Claims 9 to 11

Claims 9 to 11 depend from amended claim 1 and are patentable for at least the same reasons as amended claim 1. Furthermore, claims 9 to 11 are patentable for the following reasons.

The Examiner rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Guenther et al., McCormick et al., and U.S. Patent No. 6,459,160 ("Goldmann et al."). Addressing claim 9, the Examiner found Fig. 2 of Goldmann et al. to disclose a caulking agent having multiple layers 142, 152, and 54. Applicant respectfully traverses.

Goldmann et al. does not disclose a caulking agent having multiple layers. Goldmann et al. refers to layer 142 as a "metal cover adhesion frame," layer 152 as a "solder" or a "solder frame preform," and layer 54 as a "polymeric cushion-frame." As can be seen from Fig. 2 of Goldmann et al., frame 142, solder 152, and frame 54 form a bonding structure used to fix a chip cover 112 to a chip carrier 114. Frame 142, solder 152, and frame 54 therefore are not layers of a caulking agent used to reinforce a bonding agent at the interior or the exterior surface of a gasket. Thus, claim 9 is patentable over the cited references.

Claim 10 depends from claim 9 and is patentable over the cited references for at least the same reasons as claim 9.

The Examiner rejected claim 11 under 35 U.S.C. § 103(a) as being unpatentable over the APA in view of Guenther et al., McCormick et al., and U.S. Patent No. 6,046,074 ("McHerron et al."). Specifically, the Examiner found Fig. 5 of MCHerron et al. to disclose a caulking agent having multiple layers of the same material. Applicant respectfully traverses.

McHerron et al. does not disclose a caulking agent having multiple layers of the same material. Like Goldmann et al., Fig. 5 of MCHerron et al. discloses two tri-metal bonding structures used to fix a cap 12 to a chip carrier 114. The bonding structures each include chromium, nickel, and gold metal layers that are not layers of a caulking agent used to reinforce a bonding agent at the interior or the exterior surface of a gasket. Thus, claim 11 is patentable over the cited references.

Claims 5, 7, and 8


Applicant has canceled claims 5, 7, and 8, thereby rendering their rejections moot.

Allowable Subject Matter


Applicant thanks the Examiner for indicating that claims 20 and 23 are allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant has not amended claims 20 and 23 to independent form because Applicant believes base claim 1 is patentable over the cited references.

Summary

In summary, claims 1 to 11 and 20 to 23 were pending in the present application when last examined; claims 12 to 19 were withdrawn. Applicant has amended claims 1, 11, 20, and 23, and canceled claims 5, 7, and 8. For the above reasons, Applicant respectfully requests the Examiner to withdraw the claim objection and rejections and allow claims 1 to 4, 6, 9 to 11, and 20 to 23. Should the Examiner have any questions, please call the undersigned at (408) 382-0480x206.

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Respectfully submitted,


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